

¹The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 65

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte EDWARD HERBERT

Appeal No. 2002-0629
Application No. 08/236,378

HEARD: OCTOBER 10, 2002

Before STAAB, NASE and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 4, 16 and 19. Claims 10 and 13-15 have been canceled (Paper No. 46) and claims 17, 18 and 20-24 have been canceled (Paper No. 56, subsequent to the final rejection). Appellant "withdrew" claims 1-3, 5-9, 11 and 12 (Paper No. 26), which the examiner (Paper No. 33) apparently interpreted as cancellation of these claims.

BACKGROUND

The appellant's invention relates to power converters and, more particularly, to a method of manufacturing a module comprising at least one transformer module. A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The examiner relied upon the following as evidence of obviousness in rejecting the appealed claims:

Miller	3,474,371	Oct. 21, 1969
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Appellant's admitted prior art at page 6, lines 1-10, and page 12, lines 1-15 of the instant specification (AAPA)

Claims 4, 16 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller in view of AAPA.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the answer (Paper No. 58) for the examiner's complete reasoning in support of the rejection and to the brief and reply brief (Paper Nos. 57 and 59) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification² and claims, the applied prior art, the declaration of Charles E. Mullett (part of Paper No. 46) and the respective positions articulated by the appellant and the examiner. After reviewing all of the evidence of record, we cannot sustain the examiner's rejection.

Claim 4, the sole independent claim on appeal, requires, inter alia, steps of "obtaining said at least one solid magnetic core [i.e., a solid magnetic core having an electrically insulating top surface and an electrically insulating bottom surface]," obtaining electrically conductive base and top plates dimensioned to cover the bottom surface and top surface, respectively, of the core and bonding the bottom surface and top surface of the core directly to the conductive base and top plates, respectively.

Miller discloses a method of assembling a transformer device 10 comprising gathering together a plurality of stacked laminations of metallic material, each lamination being formed in either two or three pieces and clamping the laminations together using a clamp 20 at each end of the lamination stack. Miller discloses that the clamps may be made of metal which has some elasticity or resiliency across the width of the openings 42 so that, with the application of transverse force, they can be fit over

² We note that appellant submitted a substitute specification with the submission under 37 CFR § 1.129(a) (Paper No. 26). It is not apparent from our review of the record whether the examiner has approved entry of this substitute specification. Upon return of this application to the Technology Center, the examiner may wish to clarify this issue.

adjacent pairs of tabs 23, 26, 33, 36 of the laminations (column 3, lines 1-8). The clamps hold the stack tightly together so that the desired magnetic flux density can be produced and so that there is no noise produced by eddy currents and other effects acting on loose laminations and lamination pieces (column 2, lines 37-42).

Miller's "magnetic core" is comprised of multiple parts or laminations stacked together. While the term "solid" as used by appellant (specification, page 12) is sufficiently broad to encompass a stack of laminations, we understand appellant's use of the term "solid" as requiring that any such laminations stacked together to form a core be "bonded rigidly together" as set forth on page 12 of appellant's specification and as argued by appellant on page 18 of the brief.³ Even if Miller's clamped stack of laminations were considered to be "bonded" rigidly together when clamped tightly together by the clamps 20, the steps of clamping the clamps 20 to the laminations would necessarily comprise part of the step of "obtaining at least one solid magnetic core" recited in claim 4. Miller lacks any disclosure of then bonding the bottom and top surfaces of the thus obtained solid magnetic core to base and top plates, respectively, as further called for in claim 4.

³ It is axiomatic that, in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification, and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). Moreover, limitations are not to be read into the claims from the specification. In re Van Geuns, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) citing In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). It is well settled, however, that it is entirely proper to use the specification to interpret what is meant by a word or phrase in a claim, and this is not to be confused with the improper addition of an extraneous limitation from the specification wholly apart from any need to interpret the word or phrase. In re Paulsen, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994).

Even assuming that the AAPA would have suggested insulating the top and bottom surfaces of the stack of laminations of Miller's core, as asserted by the examiner, this would still not overcome the above-noted deficiency of Miller so as to arrive at the subject matter of claim 4. Accordingly, we shall not sustain the examiner's rejection of claim 4 or claims 16 and 19 which depend from claim 4.

CONCLUSION

To summarize, the decision of the examiner to reject claims 4, 16 and 19 under 35 U.S.C. § 103(a) is reversed.

REVERSED

LAWRENCE J. STAAB
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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